

REMARKS

Prior to entry of this paper, claims 1-45 were pending in the present application. In the above amendments, claims 1, 11, 12, 19, 20, 25, 26, 30, and 42 were amended, claims 33-41 were cancelled due to non-election in response to restriction, and claim 46 was added. Therefore, after entry of the above amendments, claims 1-32 and 42-46 will be pending in this application. Applicants believe that the present application is now in condition for allowance, which prompt and favorable action is respectfully requested.

Claim Rejections – 35 U.S.C. § 101

Claims 20 and 42 were rejected as being directed to non-statutory subject matter. Claims 20 and 42 have been amended to more clearly indicate the statutory subject matter of the claimed inventions. More specifically, claim 20 has been amended to recite an accounting module encoded on a computer-readable medium, and claim 42 has been amended to more clearly claim a computer-implemented method. Accordingly, Applicants submit that the rejections have been overcome.

Claim Rejections – 35 U.S.C. § 103

Claims 1-32 and 42-45 stand rejected under 35 U.S.C. § 103 over “Javed” (U.S. Patent Publication 2001/0036271 A1) in combination with “Edelman” (U.S. Patent Publication 2002/0029347). The Office Action states that Javed teaches each element of the independent claims, except that Javed does not teach deleting a subscription-based application or transmitting application deletion data. Edelman is cited as teaching deleting a subscription-based application and transmitting deletion data.

Javed

As best Applicants can determine, Javed teaches little, if anything, more than a system for enabling subscription-based rental of digital media content. More specifically, Applicants submit that Javed teaches a system for downloading digital media content which is encrypted to a set-top box or the like. Each time a user attempts to view the digital media content, logic or functionality at the set-top box communicates with the rental source network to determine if the user continues to have the authority to view the digital media content. If so, the content may be viewed. *See* Javed, paras 0051-0056. Notably, nothing in Javed teaches or suggests issuing deletion data back to the rental source network to terminate a subscription.

Edelman

As best Applicants can determine, Edelman describes a system for preventing the unauthorized access of electronic data installed on a computing device. A subscription-based software application is downloaded to an electronic device where a licensing medium is used to prevent unauthorized access to the software application. Importantly, the system of Edelman requires that the user install a “client program” to install and register the software application (Edelman at col. 0074), and that the user run a “removal program” that controls the removal of the software application and reporting of such removal to the registration authority (Edelman at col. 0096). Thus, the system of Edelman suffers from the same shortcomings identified by Applicants at paragraph [0006] of the specification, namely the requirement of affirmative steps and active involvement of the user to end the subscription.

In contrast, the present invention overcomes the shortcomings of the Edelman system by passively notifying an accounting module of the deletion of a subscription-based software application, rather than through the active participation of the user required by Edelman. As discussed by Applicants at paragraph [0034] of the specification, the wireless device simply

receives a request from the user to delete the software application, and then performs the steps, not necessarily under control of the user, of deleting the software application from the wireless device and transmitting the application deletion data to the accounting module. The application deletion data transmission may be when the software application is deleted or thereafter. (Specification at [0034]).

More specifically, each of the independent claims, as amended, includes passively transmitting application deletion data from the wireless device to the accounting module. In other words, unlike the system of Edelman, a user need not necessarily run a separate removal and un-registration program to delete the software application. Rather, the user need only delete the software application, and logic or functionality of the wireless device generates the application deletion data and transmits that data to the accounting module.

This distinction is significant because of the advantages Applicants' system provides over the system of Edelman. For example, Applicants' claimed invention requires less involvement by the user in the removal process of the subscription-based software application, and in the termination of the subscription. For this reason, users are less likely to suffer the frustration of being continuously billed for an ongoing subscription because the user is not sufficiently sophisticated to navigate the several installation and removal programs envisioned by the Edelman system.

Improper Hindsight Reconstruction

Applicants note that in order for prior art references to be combined by obviousness, at a minimum, there must be a suggestion of desirability for the modification. In addition, there must be a teaching or suggestion to make the combination and a reasonable expectation of success must be both found in the prior art, and not based on Applicants' disclosure. Further, the level of skill in the art cannot be relied upon to provide the suggestion to combine references.

Applicants respectfully submit that the Office Action uses improper hindsight reasoning by suggesting it would have been obvious to combine Javed with Edelman to achieve Applicants' claimed invention without providing any teaching or suggestion found in the references. Rather, the Office Action indicates that the combination would be obvious because it would allow a user to terminate a licensing agreement. (Office Action, page 4 line 13). Applicants submit that the use of one of the Applicants' own motivations as the sole justification to combine references without citing such a teaching in those references is the quintessence of a hindsight reconstruction.

Applicants respectfully submit that the art of record does not teach or suggest every limitation of the independent claims. Moreover, Applicants submit that the Office Action has used hindsight reconstruction to improperly combine references. Accordingly, Applicants submit that independent claims 1, 11, 12, 19, 20, 25, 26, 30, and 42 are allowable over the art of record. In addition, dependent claims 2-10, 13-18, 21-24, 27-29, and 43-45 are submitted as allowable for at least the same reasons.

New Claim

Applicants have added new claim 46, which Applicants submit is allowable over the art of record for at least the same reasons given above. No new matter has been submitted.

CONCLUSION

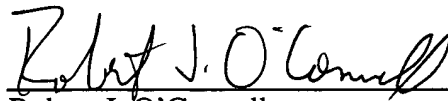
In light of the amendments contained herein, Applicants submit that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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